

## **REMARKS**

### **A. Election/Restriction**

Applicant notes with appreciation that the Office Action of April 10, 2003 has reconsidered the restriction of claim 6 and so claim 6 has been examined.

### **B. Objection to Claims**

Claims 13 and 32 were objected to for an informality. In particular, the Office Action pointed out that Applicant's Amendment filed on January 13, 2003 made a reference to canceling 13 while at the same time amending claim 13. Applicant asserts that the canceling of claim 13 was an inadvertent error as evidenced by the amendment of the claim in the same Amendment. Accordingly, Applicant requests that the reference to the cancellation of claim 13 be ignored and the claim be treated as amended in Applicant's Amendment of January 13, 2003. Assuming that this request is honored, claims 13 and 32 are clear in meaning and so the objection has been overcome and should be withdrawn.

### **C. 35 U.S.C. § 103**

#### **1. Bartoli, SPORTS book and Motooka et al.**

##### **a. Claims 2-4, 7-11, 13, 15-18, 32-37**

Claims 2-4, 7-11, 13, 15-18 and 32-37 were rejected under 35 U.S.C. § 103 as being obvious in view of Bartoli, the SPORTS book and Motooka et al. Applicant traverses this rejection. The Office Action has conceded that Bartoli does not disclose using an identification label with its base. The Office Action has further asserted that it would have been obvious to add an identification label to the base of Bartoli in view of the base shown in the SPORTS book. However, independent claims 7 and 8 each recite a cutout into which an identification label is

inserted. The base shown in the SPORTS book does not disclose or suggest forming a cutout in either the top face or a side wall of Bartoli and inserting an identification label therein.

Motooka et al. does not solve the deficiencies of Bartoli and the SPORTS book. While Motooka et al. discloses inserting a nameplate 10 in a glove, Motooka et al. is directed to nonanalogous art and so cannot be combined with either Bartoli and the base shown in the SPORTS book.

The test for nonanalogous art is as follows:

The determination that a reference is from nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986) citing In re Wood, 559 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979).

Upon applying the first test, it is apparent that Motooka et al. is not within the Applicant's field of endeavor. Applicant's claimed invention is in the field of baseball or softball bases. In contrast, Motooka et al. is directed to baseball gloves.

Besides not being within the field of the inventor's endeavor it is clear that Motooka et al. is not reasonably pertinent to the particular problem with which the Applicant's were involved. As stated on page 1 of Applicant's specification, one of the problems attempted to be solved is that bases do not have the ability to be identified as a game or event specific item that would make it a collectible item.

Upon reviewing Motooka et al., it is apparent that Motooka et al. does not address Applicant's problems. In particular, Motooka et al. is directed to solving the problem that it is difficult to exchange a player's uniform number, playing position or name on baseball gloves

(Col. 1, ll. 14-28). Since Motooka et al. is not reasonably pertinent to Applicant's particular problems, Motooka et al. fails the second test. Accordingly, it is respectfully submitted that a person having ordinary skill in the art of designing improved bases would not, without other suggestion, turn to the completely non-analogous devices of baseball gloves to find answers for improved bases. It is noted that the Office Action has indicated that Motooka et al. is in the field of personalizing baseball paraphernalia. This characterization is overbroad. Motooka et al. is in the field of personalizing baseball catching devices and is not related to baseball bases at all. For the above reasons alone it is felt that the argued combination is inappropriate and that the rejection should be withdrawn.

Even if Motooka et al. is considered to be analogous art, the rejection is improper because there is no motivation to use Motooka et al.'s nameplate 10 on Bartoli's base. In particular, Motooka et al.'s structure includes a fitting 3 that extends beyond the leather surface of its glove. Having a fitting extend above the top surface of Bartoli's base could lead to players tripping on fitting. Having the fitting extend beyond the side wall of Bartoli's base could lead to the cleats of the player catching on the fitting and possibly leading to injury. Since there is no motivation to use a nameplate in Bartoli's base per the teachings of Motooka et al., the rejection of claims 2-4, 7-11, 13, 15-18 and 32-37 should be withdrawn.

**b. Claims 14, 38-40, 42, 43 and 45-48**

Claims 14, 38-40, 42, 43 and 45-48 were rejected under 35 U.S.C. § 103 as being obvious in view of Bartoli, the SPORTS book and Motooka et al. Claim 14 has been canceled and so its rejection has been rendered moot. Claims 42 and 43 have been amended so as to be in independent form and each recites a cutout into which an identification label is inserted. For

reasons similar to those given above in Section C.1.a., the above combination is improper and neither the SPORTS book nor Motooka et al. disclose or suggest altering Bartoli's to include a cutout to have an identification label inserted therein. Accordingly, the rejections are improper and should be withdrawn.

As mentioned above, claims 42 and 43 have been amended so as to incorporate subject matter that was inherently present in the original claims 42 and 43. Accordingly, the amendments made to claims 42 and 43 are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722, 122 S. Ct. 1831 (2002). In addition, claims 38, 45 and 47 have been amended so as to provide additional coverage for the base of claim 14 and so the amendments are not related to patentability as defined in *Festo*.

**2. Bartoli, SPORTS book, Motooka et al. and Kennedy, III et al.**

Claims 5, 6, 12, 41 and 44 were rejected under 35 U.S.C. § 103 as being obvious in view of Bartoli, the SPORTS book, Motooka et al. and Kennedy, III et al. Applicant traverses this rejection. Claims 5, 6, 12, 41 and 44 depend directly or indirectly on claims 7, 8 and 43 and so they each recite a cutout into which an identification label is inserted. Kennedy, III et al. does not suggest forming a cutout in Bartoli's base to have an identification label inserted therein. Without such suggestion, the rejection is improper and should be withdrawn.

The rejection should be withdrawn for the additional reason that Kennedy, III et al. is directed to nonanalogous art. In particular, Kennedy, III et al.'s field of endeavor is in the field of game balls (Col. 1, ll. 11-13) while Applicant's claimed invention is in the field of baseball or

softball bases. It is noted that the Office Action has indicated that Kennedy, III et al. is in the field of applying indicia to sports paraphernalia. As with Motooka et al., this characterization is overbroad. Kennedy, III et al. is in the field of basketballs and is not related to baseball bases at all. Besides not being within the field of the inventor's endeavor, Kennedy, III et al. is not reasonably pertinent to Applicant's particular problem that bases do not have the ability to be identified as a game or event specific item that would make it a collectible item. Kennedy, III et al. is directed to the problem of placing a medallion on a gameball (Col. 1, ll. 16-47).

**D. New Claims 49-56**

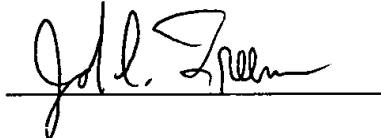
New claim 49-56 depend directly or indirectly on claim 42 and so are patentable over Bartoli, the SPORTS book and Motooka et al. for at least the same reasons given above in Section C.1.b.

Please note that new claims 49-56 are being present to provide additional coverage for a base. Accordingly claims 49-56 are not being presented for reasons of patentability as defined in *Festo*.

### CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 2-5, 7-13, 15-18 and 32-56 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

John C. Freeman  
Registration No. 34,483  
Attorney for Applicant

BRINKS HOFER  
GILSON & LIONE  
P.O. Box 10395  
Chicago, Illinois 60610  
(312) 321-4200

Dated: September 10, 2003